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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/938,468 08/14/96 HOLT

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022913 TM02/0103
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EXAMINER

BASHORE, W

ART UNIT

PAPER NUMBER

2176

DATE MAILED:

01/03/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/938,468

Applicant(s)

Holt, Nick et al.

Examiner

William L. Bashore

Group Art Unit

2176



☒ Responsive to communication(s) filed on Aug 31, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 2-42 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 2-42 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. This action is responsive to communications: application filed on 8/14/1996 (Rule 60). Preliminary amendment filed on 4/21/1998, and IDS filed on 4/21/1998.
2. It is noted that this application has the following continuation history: application 08/334,616 (now Patent No. 5,557,723) ; application 08/207,231 filed 3/7/1994 (abandoned) ; and application 07/621,444 filed 11/30/1990 (abandoned).
3. Claims 2-42 are pending in this case. Claim 1 has been canceled. Claims 2, 7, 12, 19, 29, 33, 38 are independent claims.

Specification

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested: Method And System For Customizing Forms In An Electronic Mail System Utilizing Custom Field Behaviors And User Defined Operations
5. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Claim Objections

6. Claim 38 is objected to because of the following informalities: the phrase "*for each of a plurality of field*" should be changed to "*for each of a plurality of fields*". Appropriate correction is required.

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Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. **Claims 3, 5, 6, 7, 11, 12, 13, 15, 16, 19, 20, 30, 31, 32, 33, 34, 39, 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

In regard to dependent claim 3, the phrase “*form flags*” is vague and indefinite. It is unclear what this means in the context of Applicant’s invention.

In regard to dependent claim 5, the phrase “*the primary key designating a location of the form control procedure*” is vague and indefinite. It is unclear how one can designate a physical location to a performed procedure.

In regard to claims 6, 7, 11, 13, 15, 16, 19, 20, 30, 31, 32, 33, 34, 39, 41, the phrase “*a standard behavior*” is vague and indefinite. It is unclear what a standard behavior is defined as. The Examiner’s suggestion of changing said phrase to “*a behavior*” in each of said claims will overcome the Examiner’s rejections to said claims.

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In regard to independent claim 12, the phrase "*based on the performance of the custom behavior*" is vague and indefinite. Performance is a term implying the judging of an event, process, or object, and is not understood within the context of Applicant's invention regarding a custom behavior.

Examiner's Notes

For the following rejection regarding claim 3, the Examiner interprets a "form flag" as an indication of something.

For the following rejection regarding claim 5, the Examiner interprets the phrase "*the primary key designating a location of the form control procedure*" as a primary key designating a location of the form.

For the following set of rejections regarding claims 6, 7, 11, 13, 15, 16, 19, 20, 30, 31, 32, 33, 34, 39, 41, the Examiner interprets the phrase "*a standard behavior*" as the following: "*a behavior*".

For the following rejection regarding claim 12, the Examiner interprets the phrase "*based on the performance of the custom behavior*", as based on a custom behavior.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. **Claim 2 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

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In regard to independent claim 2, claim 2 (preamble) states "*A computer-readable medium containing a data structure describing a custom form...*". This phrase can be interpreted as a computer diskette containing a text file describing a custom form, thereby rendering said claim as directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 2-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Texier, U.S. Patent No. 5,119,476 issued June 1992, in view of Karnik, U.S. Patent No. 5,404,294 issued April 1995.**

In regard to independent claim 2, the Examiner interprets claim 2 preamble as reflecting computer readable code to accomplish the limitations of claim 2.

Texier teaches the creation of a form (Texier column 1 lines 61-63; compare with claim 2 preamble).

Texier teaches a form header containing data describing a window in which fields are displayed (Texier column 3 lines 42-43; compare with claim 2 "*a form header containing data describing a window into which fields are to be displayed on a device*").

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Texier teaches zones which are equivalent to fields, said zones containing associated descriptions and behaviors (Texier Figure 1 items P1-P7, also column 6 lines 46-56; compare with claim 2 “*a description of the field*”).

Texier teaches a form control procedure to implement a procedure associated with certain fields (Texier column 8 lines 5-12; compare with claim 2 “*a form control procedure for receiving data that is input into the field...*”). Texier does not specifically teach a custom behavior for a field indicating user defined operations. However, Karnik teaches a form system whereby tags (fields) can be linked to other tags arithmetically using different mathematical functions (Karnik column 6 lines 8-17; compare with claim 2 “*...for determining whether to perform a custom behavior for the field, and for performing the custom behavior for the field, the custom behavior indicating user-defined operations associated with the field.*”). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Karnik to Texier, because of Karnik’s taught advantage of tag linking, providing a way to incorporate formulas (a custom behavior) into the forms of Texier.

In regard to dependent claim 3, Texier teaches the creation of a form header (Texier column 3 lines 42-43). Texier does not specifically teach a primary key. However, Karnik teaches a primary key (Karnik column 5 lines 53-57; compare with claim 3 “*a primary key*”). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Karnik to Texier, because of Karnik’s taught advantage of primary keys, providing a way to link the forms of Texier to a database.

Texier teaches the creation of form flags, and form coordinates specifying the appearance, position, and size of a window (Texier column 4 lines 16-23; compare with claim 3 “*form flags*”, and “*form coordinates for specifying the position and size of the window*”).

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Texier teaches a character string for use as a form title (Texier Figure 1 item EMPLOYEE INFORMATION, also column 4 line 23; compare with claim 3 “*a character string for use as a form title*”).

In regard to dependent claim 4, Texier does not specifically teach primary/secondary keys, or a unique identifier for a field. However, Karnik teaches a tag with a unique set of properties, and can act as a key to an attached set of properties (Karnik column 2 lines 50-55; compare with claim 4 “*a primary key...location of the description*”, and “*a secondary key...unique identifier for the field*”). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Karnik to Texier, because of Karnik’s taught advantage of keys, providing a way to link the forms of Texier to a database.

Texier teaches the creation of a field type and field attributes (Texier column 6 lines 46-56; compare with claim 4 “*a field type*”, and “*attributes of the field*”).

Texier teaches field placement (Texier Figure 1 item P1-P7; compare with claim 4 “*coordinates of the field*”). Referencing the location of an object on a computer screen by position coordinates is known in the software art.

Texier teaches font characteristics (Texier Figure 1 items P1-P7, also Figure 2; compare with claim 4 “*font characteristics of the field*”).

In regard to dependent claim 5, Texier does not specifically teach a primary key for retrieving and designating a location of a form control procedure (form). However, However, Karnik teaches a tag with a unique set of properties, and can act as a key to an attached set of properties (Karnik column 2 lines 50-55; compare with claim 5 “*a primary key...location of the form control procedure*”). It would have been

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obvious to one of ordinary skill in the art at the time of the invention to apply Karnik to Texier, because of Karnik's taught advantage of keys, providing a way to link the forms of Texier to a database.

A "*custom behavior*" has been previously addressed (see claim 2 rejection). Computer code to implement various methods is known in the software art.

In regard to dependent claim 6, Texier teaches a form with an active field triggering a validation event subsequent to user input of data into said field (Texier column 2 lines 8-15; compare with claim 6).

In regard to independent claim 7, Texier teaches the creation of a custom form (Texier column 1 lines 61-63; compare with claim 7 preamble).

Texier teaches a form with an active field triggering a validation event subsequent to user input of data into said field (Texier column 2 lines 8-15; compare with claim 7 "*a standard behavior*").

Texier teaches a form header containing data describing a window in which fields are displayed (Texier column 3 lines 42-43; compare with claim 7 "*providing a description of each field....to obtain data*").

Texier teaches zones which are equivalent to fields, said zones containing associated descriptions and behaviors, as well as a form control procedure to implement a procedure associated with certain fields (Texier Figure 1 items P1-P7, column 6 lines 46-56, also column 8 lines 5-12; compare with claim 7 "*providing a form control procedure for the custom form....which the data is directed*").

Texier teaches display of a form, receiving data invoking a procedure to accept data from a field (Texier Figure 1, also column 2 lines 8-15; compare with claim 7 "displaying the custom form on a display device", "receiving data...", "invoking a form control procedure...").

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Texier does not specifically teach a custom behavior for a field indicating user defined operations. However, Karnik teaches a form system whereby tags (fields) can be linked to other tags arithmetically using different mathematical functions (Karnik column 6 lines 8-17; compare with claim 7 “*under control of the invoked form control procedure....which the data is directed.*”). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Karnik to Texier, because of Karnik’s taught advantage of tag linking, providing a way to incorporate formulas (a custom behavior) into the forms of Texier.

In regard to dependent claim 8, claim 8 incorporates substantially similar subject matter as claimed in claim 7, and in further view of the following, is rejected along the same rationale.

Texier teaches a form containing a plurality of input fields (Texier Figure 1; compare with claim 8).

In regard to dependent claim 9, claim 9 incorporates substantially similar subject matter as claimed in claim 7, and in further view of the following, is rejected along the same rationale.

Texier teaches a form containing a plurality of input fields said input fields can be assigned to various procedures (Texier Figure 1; compare with claim 9).

In regard to dependent claim 10, Texier teaches a displayed form containing fields placed on said form utilizing placement field data controlled by the program (Texier Figure 1, column 6 lines 46-56; compare with claim 10).

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In regard to dependent claim 11, Texier teaches a form with an active field triggering a validation event subsequent to user input of data into said field (Texier column 2 lines 8-15; compare with claim 11).

In regard to independent claim 12, Texier teaches a form header containing data describing a window in which fields are displayed (Texier column 3 lines 42-43; compare with claim 12 “*a method....receiving an indication of the field*”).

Texier does not specifically teach a custom behavior for an identified field indicating user defined operations. However, Karnik teaches a form system whereby tags (fields) can be linked to other tags arithmetically using different mathematical functions, and different types of mathematical functions can be specified (Karnik column 6 lines 8-17; compare with claim 12 “*determining whether a custom behavior has been defined for the identified field; and when a custom behavior has been defined, performing the custom behavior for the identified field....performance of the custom behavior*”). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Karnik to Texier, because of Karnik’s taught advantage of tag linking, providing a way to incorporate formulas (a custom behavior) into the forms of Texier.

In regard to dependent claim 13, Texier teaches a form with an active field triggering a validation event subsequent to user input of data into said field (Texier column 2 lines 8-15; compare with claim 13).

In regard to dependent claim 14, Texier teaches the creation of a form, a form header containing data describing a window in which fields are displayed, and zones which are equivalent to fields, said zones

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containing associated descriptions and behaviors (Texier column 1 lines 61-63, column 3 lines 42-43, Figure 1 items P1-P7, also column 6 lines 46-56; compare with claim 14).

In regard to dependent claims 15, 16, claims 15, 16 incorporate substantially similar subject matter as claimed in claim 12, and in further view of the following, is rejected along the same rationale.

Texier in view of Karnik does not specifically teach the explicit ordering of a standard behavior (validation) before or after execution of a custom behavior (combining multiple field data using a formula). However, placement of said standard behavior, either before or after a custom behavior, would have been obvious to one of ordinary skill in the art at the time of the invention, because form data validation is executed at all levels of data handling code in known mission critical software systems, providing increased data accuracy to Texier.

In regard to dependent claims 17, 18, Texier teaches data field input and display (Texier Abstract, also Figure 1; compare with claims 17, 18).

In regard to independent claim 19, Texier does not specifically teach a custom behavior for an identified field indicating user defined operations. However, Karnik teaches a form system whereby tags (fields) can be linked to other tags arithmetically using different mathematical functions, and different types of mathematical functions can be specified (Karnik column 6 lines 8-17; compare with claim 19 “*invoking a form control procedure...for optionally performing a custom behavior for the field*”). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Karnik to Texier, because of

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Karnik's taught advantage of tag linking, providing a way to incorporate formulas (a custom behavior) into the forms of Texier.

Texier teaches a form with an active field triggering a validation event subsequent to user input of data into said field, said triggering invoked by a validation button (Texier Figure 1, column 2 lines 8-15; compare with claim 19 "*receiving an indication....any standard behavior for the field*", and "*when the received....the standard behavior for the field*").

Texier in view of Karnik does not specifically teach the explicit ordering of a standard behavior (validation) before or after execution of a custom behavior (combining multiple field data using a formula). However, placement of said standard behavior, either before or after a custom behavior, would have been obvious to one of ordinary skill in the art at the time of the invention, because form data validation is executed at all levels of data handling code in known mission critical software systems, providing increased data accuracy to Texier.

In regard to dependent claim 20, Texier teaches zones which are equivalent to fields, said zones containing associated descriptions and behaviors (Texier Figure 1 items P1-P7, column 6 lines 46-56, column 8 lines 5-12; compare with claim 20).

In regard to dependent claim 21, Texier teaches a form control procedure to implement a procedure associated with certain fields, as well as zones which are equivalent to fields, said zones containing associated descriptions and behaviors (Texier Figure 1 items P1-P7, column 6 lines 46-56, column 8 lines 5-12; compare with claim 21).

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In regard to dependent claim 22, transporting forms for display in other computers systems is known in the software art.

In regard to dependent claim 23, Texier teaches a validation button (Texier Figure 1 item P7; compare wit claim 23).

In regard to dependent claims 24, 25, 26, Texier teaches a displayed form with multiple input fields (Texier Figure 1; compare with claims 24, 25, 26.

In regard to dependent claim 27, transporting data ad procedures is known in the software art.

In regard to dependent claim 28, the use of computer code for implementing procedures is known in the software art.

In regard to independent claim 29, Texier teaches a form header containing data describing a window in which fields are displayed (Texier column 3 lines 42-43; compare with claim 29 “*a computer readable medium....processing field of a form, by; for each field of the form, receiving an indication of the field*”).

Texier does not specifically teach a custom behavior for an identified field indicating user defined operations. However, Karnik teaches a form system whereby tags (fields) can be linked to other tags arithmetically using different mathematical functions, and different types of mathematical functions can be specified (Karnik column 6 lines 8-17; compare with claim 29 “*determining whether a custom behavior*

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has been defined for the identified field; and when a custom behavior has been defined, performing the custom behavior for the identified field....performed for each field of the system”). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Karnik to Texier, because of Karnik’s taught advantage of tag linking, providing a way to incorporate formulas (a custom behavior) into the forms of Texier.

In regard to dependent claim 30, Texier teaches a form with an active field triggering a validation event subsequent to user input of data into said field (Texier column 2 lines 8-15; compare with claim 30).

In regard to dependent claims 31, 32, Texier teaches a “*standard behavior*” whereby an active field triggers a validation event subsequent to user input of data into said field (Texier column 2 lines 8-15; compare with claims 31, 32).

Texier in view of Karnik does not specifically teach the explicit ordering of a standard behavior (validation) before or after execution of a custom behavior (combining multiple field data using a formula). However, placement of said standard behavior, either before or after a custom behavior, would have been obvious to one of ordinary skill in the art at the time of the invention, because form data validation is executed at all levels of data handling code in known mission critical software systems, providing increased data accuracy to Texier.

In regard to independent claim 33, Texier teaches a form control procedure to implement a procedure associated with certain fields (Texier column 8 lines 5-12; compare with claim 2 “*a first component for invoking a form control procedure passing an indication of one of the plurality of fields*”).

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Texier does not specifically teach a custom behavior for a field indicating user defined operations. However, Karnik teaches a form system whereby tags (fields) can be linked to other tags arithmetically using different mathematical functions (Karnik column 6 lines 8-17; compare with claim 2 "*the form control procedure for optionally performing a custom behavior for the indicated field*"). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Karnik to Texier, because of Karnik's taught advantage of tag linking, providing a way to incorporate formulas (a custom behavior) into the forms of Texier.

Texier teaches a form with an active field triggering a validation event subsequent to user input of data into said field (Texier column 2 lines 8-15; compare with claim 33 "*a second component....based on the received indication*").

Texier in view of Karnik does not specifically teach the explicit ordering of a standard behavior (validation) before or after execution of a custom behavior by form control procedures (combining multiple field data using a formula). However, placement of said standard behavior, either before or after a custom behavior, would have been obvious to one of ordinary skill in the art at the time of the invention, because form data validation is executed at all levels of data handling code in known mission critical software systems, providing increased data accuracy to Texier.

In regard to dependent claim 34, Texier teaches a form with an active field triggering a validation event subsequent to user input of data into said field (Texier column 2 lines 8-15; compare with claim 34).

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In regard to dependent claim 35, Texier teaches zones which are equivalent to fields, said zones containing associated descriptions and behaviors (Texier Figure 1 items P1-P7, also column 6 lines 46-56; compare with claim 35).

In regard to dependent claim 36, transporting forms for display in other computers systems is known in the software art.

In regard to dependent claim 37, indicating events which trigger invocation of a procedure (ie. a button) is known in the software art.

In regard to independent claim 38, Texier teaches the creation of a form (Texier column 1 lines 61-63; compare with claim 38 preamble).

Texier teaches a form header containing data describing a window in which fields are displayed (Texier column 3 lines 42-43; compare with claim 2 “storing *a form header containing data describing a window into which fields are to be displayed*”).

Texier teaches zones which are equivalent to fields, said zones containing associated descriptions and behaviors (Texier Figure 1 items P1-P7, also column 6 lines 46-56; compare with claim 38 “*a description of the field*”).

Texier teaches a form control procedure to implement a procedure associated with certain fields (Texier column 8 lines 5-12; compare with claim 38 “storing *a form control procedure for receiving an indication of an event...*”). Texier does not specifically teach a custom behavior for a field indicating user defined operations. However, Karnik teaches a form system whereby tags (fields) can be linked to other tags

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arithmetically using different mathematical functions (Karnik column 6 lines 8-17; compare with claim 38 “...for performing a custom behavior for one of the plurality of the fields based on the indicated event”). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Karnik to Texier, because of Karnik’s taught advantage of tag linking, providing a way to incorporate formulas (a custom behavior) into the forms of Texier.

In regard to dependent claim 39, Texier teaches a form with an active field triggering a validation event subsequent to user input of data into said field (Texier column 2 lines 8-15; compare with claim 39).

In regard to dependent claim 40, Texier teaches the creation of a field type and field placement (Texier column Figure 1 item P1-P7, also column 6 lines 46-56; compare with claim 40)

In regard to dependent claims 41, 42, Texier in view of Karnik does not specifically teach the explicit ordering of a standard behavior (validation) before or after execution of a custom behavior (combining multiple field data using a formula). However, placement of said standard behavior, either before or after a custom behavior, would have been obvious to one of ordinary skill in the art at the time of the invention, because form data validation is executed at all levels of data handling code in known mission critical software systems, providing increased data accuracy to Texier.

Conclusion

13. **Prior art made of record and not relied upon is considered pertinent to disclosure.**

Luchs et al.	U.S. Patent No. 4,831,526	issued	May	1989
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Bier U.S. Patent No. 5,862,395 issued January 1999

Morris, James H. Et al., Andrew: a distributed personal computing environment, Communications of the ACM, Volume 29, Issue 3, March 1986, pp. 184-201.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Bashore whose telephone number is (703) 308-5807. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186. The fax number to this art unit is (703) 308-6606.

 Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

15. **Any response to this action should be mailed to:**

 Commissioner of Patents and Trademarks
 Washington, D.C. 20231


or faxed to:

 (703) 308-9051, (for formal communications intended for entry)

or:

 (703) 305-9724 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).


HEATHER R. HERNDON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

William L. Bashore
12/27/2000